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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,591	05/25/2005	Udo Lehmann	WSP229US	2918
24041	7590	11/15/2005	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			TRAN, HUAN HUU	
			ART UNIT	PAPER NUMBER
			2861	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,591

Applicant(s)

LEHMANN ET AL.

Examiner

Huan H. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Preliminary Amendment filed on 09/03/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-62, 64-72, 81-88, 92 and 96-100 is/are rejected.
- 7) ☒ Claim(s) 63, 73-80, 89-91, 93-95 and 101 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 62 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 62 depends on a canceled claim. It should be made dependent on claim 61.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 54, 55, 58, 59, 60, 61, 64, 65, 66, 68, 69, 81, 82, 83, 96 are rejected under 35 U.S.C. 102(e) as being anticipated by Lehmann (US 2003/0156178)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 54, 58 and 59, with reference to Fig. 2(c) Lehmann discloses a printing apparatus and process for the transfer of printing substance (8) from an ink carrier (2) to an imprinting material (), in which, with the help of an energy-emitting apparatus, which, during a process period, emits energy in the form of electromagnetic waves (7), and the printing substance (8) undergoes a change in volume and/or position, wherein, with the help of absorption bodies (10 dispersed into the printing substance 8 at paragraph [0067]), energy is transferred from the electromagnetic waves (7) into the printing substance (8).

As to claim 55, Lehmann teaches the limitation that the size of the absorption bodies (10) being smaller than the wavelength of the electromagnetic waves (7). See paragraph [0048].

As to claims 60, 61, Lehmann teaches the limitations "wherein the absorption bodies absorb essentially all the light wavelengths" and "wherein the absorption bodies (4) absorb essentially only the radiation with a wavelength or in a wavelength range which corresponds to the wavelength or wavelength range of the electromagnetic waves 3 emitted by the energy-emitting apparatus". See last 5 lines of paragraph [0014].

As to claim 64, Lehmann teaches the limitation wherein an ink carrier (1) is used, on whose surface provided to receive the printing substance (2) absorption bodies (4) are present

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which form a solid layer". See Fig. 8 which shows a solid layer 10 of absorption bodies on a surface of an ink carrier 2.

As to claims 65, 66, 67 and 68, Lehmann teaches the limitation "wherein printing-point size is controlled by the quantity of energy released by the energy-emitting apparatus" and the limitation "wherein the quantity of energy released by the energy-emitting apparatus is controlled by a process period". See paragraphs [0018] and [0071] which describe controlling of the pulse energy and the pulse length in order to control the printing point quantity. As the result of variations in printing point size, the differences in brightness of the image are achieved (claim 68):

As to claim 69, Lehmann teaches the limitation that the process period is shorter than 1 μ s. See paragraph [0020].

As to claim 81, it is submitted that Lehmann teaches the limitation that through the change in volume and/or position of the printing substance some of the printing substance (10) is removed from the ink carrier (2) and is at least partly transferred to the imprinting material.

For the same explanation above, Lehmann discloses the claimed printing machine for printing on an imprinting material with an ink carrier and an energy-emitting apparatus, which is arranged such that the energy can be transferred in a targeted manner onto certain areas of the ink carrier, wherein absorption bodies on the ink carrier are provided for absorbing the energy.

As to claim 83, the energy-emitting apparatus in Lehmann is a laser.

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As to claims 84-86, 87 , 88, 92 see paragraph [0048].

As to claim 96, it is clearly seen that the printing substance (8) in Lehmann includes absorption bodies (10).

As to claims 97 and 98, see paragraph [0048].

As to claim 99, see the description of the ink carrier with reference to Figs. 1-2.

As to claim 100, see [0067].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 56, 57, 70-72 are rejected under 35 U.S.C. 103(a) as being obvious over Lehmann .

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

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invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

As to claims 56 and 57, Lehmann discloses the claimed invention except for the optimum size of the absorption bodies (10). See paragraph [0048]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the optimum size of the absorption bodies, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As to claims 70-72, Lehmann teaches that the process period (pulse length) is advantageously less than 1 μ s, preferably less than 500ns. See paragraph [0020]. It would have been obvious to one of ordinary skill in the art to discover the optimum or workable ranges of the process period by routine experimentation given the teaching of Lehmann. See MPEP 2144.05 citing *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)

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Allowable Subject Matter

8. Claims 6373-80, 89-91, 93-95, 101 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number is (571) 272-2261. The examiner can normally be reached on at work on W-F from 6:30 to 5; T are telework days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Huan H. Tran
Primary Examiner
Art Unit 2861

hht
11/10/05